



PATENT
2008-0108P

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of	Before the Board of Appeals
Ernest J. CLAXTON, III et al.	Appeal No.:
Application No.: 09/034,313	Group: 3745
Filed: March 4, 1998	Examiner: C. Verdier
For: FIELD-SERVICEABLE SOLIDS HANDLING VERTICAL TURBINE PUMP	

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REPLY BRIEF ON BEHALF OF APPELLANTS UNDER 37 C.F.R. § 1.193(b)

Assistant Commissioner for Patents
Washington, DC 20231

May 21 2001

Sir:

This is a Reply Brief to the Examiner's Answer mailed March 19, 2001, the Reply Brief now due by May 19, 2001 (a Saturday).

New Points of Argument Raised by Examiner's Answer

Appellants are providing this Reply Brief to respond to new points of argument raised in the Examiner's Answer. Appellants do not disagree with paragraphs (1) - (10) of the Examiner's Answer. The specific new points of argument that are addressed in paragraph (11) to which Appellant disagrees are as follows:

- I. The Examiner's assertion that the Federal Circuit's decision in *In re Clement*, 45 U.S.P.Q.2d 1161 (Fed Cir. 1997) is controlling legal authority for the facts of this case and, as such, supports rejecting claims 15-16, 19-21, and 24-25 under the recapture rule.
- II. The Examiner's assertion that reciting bearings, as opposed to one or more bearings, in the separable bearing cartridge of the claimed vertical turbine pump was a significant and essential feature the '857 Application.
- III. The Examiner's assertion that, by failing to submit "Comments" on the Examiner's Reasons for Allowance in the '857 Application, Appellants acquiesced that bearings, as opposed to one or more bearings, was essential to patentability of claim 1.

RESPONSE

I. THE EXAMINER'S ASSERTION THAT THE FEDERAL CIRCUIT'S DECISION OF *IN RE CLEMENT* IS CONTROLLING LEGAL AUTHORITY THAT DICTATES THE OUTCOME OF THIS CASE

The Examiner asserts at pages 4-5 of the Answer that the Federal Circuit's decision in *In re Clement* is "controlling legal authority" for the facts of this case. Appellants respectfully submit that the Federal Circuit's holding in that case does

not support a rejection under the recapture rule for the claims at issue because the facts of this case are clearly distinguishable.

1. The Federal Circuit's Holding in *In re Clement*

The Federal Circuit stated in *In re Clement* (the case relied on almost exclusively by the Examiner as allegedly supporting the outstanding rejection) that “[d]eliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim **before** the cancellation or amendment is unpatentable.” 45 U.S.P.Q.2d at 1164 (emphasis added). Thus, the Federal Circuit in *In re Clement* defined “surrendered” claim scope in terms of the pre-amended or canceled claim scope.

2. The Facts of this Case

In this case, originally presented independent claim 1 of the ‘857 Application recited a vertical turbine pump comprising, *inter alia*, a pump bowl assembly, a rotary impeller, and a diffuser core. Originally-presented dependent claim 4 recited a vertical turbine pump as defined in claim 1, further comprising: “a bearing cartridge separably fastened within said diffuser core, said bearing cartridge carrying axially space bearings which surround and rotatably support said drive shaft.” In an Office Action dated April 25, 1995, Examiner Larson rejected independent claim 1 but indicated allowability of dependent claim 4 (as well as other claims). In an Amendment dated July 24, 1995, claim 1 was amended to recite the “bearing cartridge” specified in allowable dependent claim

4 and claim 4 was cancelled. The '857 Application was subsequently allowed and issued on March 5, 1996 as U.S. Patent 5,496,150 ("the '150 patent").

Appellants filed this reissue application based on their belief that the '150 patent contained errors as claiming less than Appellants had the right to claim. Such errors arose without deceptive intent. Claim 1 of the '150 patent erroneously recited specific details that unduly limited the scope of claim 1 in such a manner that a fundamental patentable feature that was a focus of the application was not adequately protected. [pg. 4 of the Supplemental Reissue Declaration filed January 7, 2000]. One such detail related to the recited "bearing cartridge" which was specified in patent claim 1 as requiring "axially spaced bearings" (i.e., a plurality of bearings instead of also covering an arrangement in which a single bearing is included in the separable bearing cartridge). Appellants did not consider, however, the inclusion of a plurality of bearings to be a significant aspect of their invention, and this language was merely carried over to claim 1 with the other language of allowable dependent claim 4.

In any event, the claims at issue are materially narrower than pre-amended claim 1 of the '857 Application, which did not recite a removable bearing cartridge. Thus, it cannot be said that the Federal Circuit's decision in *In re Clement*, which defined "surrendered" claim scope in terms of the pre-amended/cancelled claim, supports the rejection under the recapture rule in this case.

3. The Examiner's Definition of "Surrendered" Claim Scope

The Answer's definition of "surrendered" claim scope finds no support in the Federal Circuit's holding in *In re Clement*. On page 6, 1st full ¶, the Answer defines "surrendered" claim scope as "the subject matter of claim 1 in the issued patent." This definition is clearly wrong. On page 8, lines 1-3, the Answer defines "surrendered" claim scope as "what was added to then pending claim 1 to make it allowable and issue as patent claim 1." This definition is also clearly wrong.

In essence, the Examiner's rejection stands for the proposition that, when an Applicant incorporates the entirety of an allowable dependent claim into a rejected independent claim, the recapture rule bars the Applicant from later seeking a broadening reissue which in any way broadens features that were recited in the allowable dependent claim. The Examiner has cited no legal authority that dictates such a rule of law and instead misapplies the Federal Circuit's holding in *In re Clement* to reject claims under the recapture rule.

II. THE EXAMINER'S ASSERTION THAT A PLURALITY OF BEARINGS IN THE BEARING CARTRIDGE WAS DEEMED BY APPELLANTS TO BE A SIGNIFICANT ASPECT OF THEIR INVENTION

The Answer asserts at page 9 that

a plurality of axially spaced bearings is a significant feature of the invention because Appellants mentioned this feature in the "Summary of the Invention" section, and stated that the feature of the bearing cartridge carrying axially spaced bearings realizes one of the objects of the invention, i.e., providing a solids-handling vertical turbine pump having bowl bearings which can be readily serviced in the field.

Appellants disagree with the Examiner's conclusion that the Summary, Objects of the Invention, or any other portion of the specification indicates that Appellants considered a plurality of bearings, as opposed to one or more bearings, in the separable bearing cartridge as being a significant or essential aspect of their invention.

Initially, Appellants disagree with the Examiner's conclusion that merely mentioning a detail of a disclosed embodiment in the Summary indicates that the detail is deemed by Appellants to be a particularly significant or essential feature of the invention. Furthermore, it should be apparent that having a plurality of bearings in the separable bearing cartridge, as opposed to a single bearing, has no relation to the stated object of providing a solids-handling vertical turbine having a bearing assembly that can be readily serviced in the field. Having a single bearing or plural bearings in the separable bearing cartridge has no impact on serviceability of the disclosed pump.

The detailed description does not suggest that Appellants considered a plurality of axially spaced bearings a significant feature for establishing patentability. The '857 Application simply placed no emphasis on this feature of the disclosed embodiment. Instead, the disclosure of the '857 Application emphasized how the vertical turbine pump configuration and the bearing cartridge therein enables an operator to service the pump in the field by accessing the bearing cartridge (which is particularly vulnerable to wear) from the upstream section of the pump casing by removing the impeller and sliding the separable

bearing cartridge off the drive shaft. [See *e.g.*, the Abstract; col. 5, ll. 17-31; and col. 1, ll. 40-51 of the '150 Patent]. Reissue claims 15 and 20 recite features of the disclosed "bearing cartridge" that emphasize this significant aspect of the disclosure, while removing the requirement that the bearing cartridge carry a plurality of bearings. For example, independent reissue claim 15 requires:

a bearing cartridge separably fastened to said diffuser core, said bearing cartridge surrounding and rotatably supporting said drive shaft, said bearing cartridge being removable from an upstream section of said casing by removing said impeller and disengaging said bearing cartridge from said diffuser core thereby permitting said bearing cartridge to be slid off said drive shaft in an axial direction.

Independent reissue claim 20 includes similar language. Thus, independent reissue claims 15 and 20, although broader than patent claim 1 in the sense that a plurality of axially spaced bearings are not required, are narrower than pre-amended claim 1 of the '857 Application (which did not require any bearing cartridge). Furthermore, independent reissue claims 15 and 20 recite and emphasize features of the "bearing cartridge" that were not recited in patent claim 1 so that the features of the claimed "bearing cartridge" are commensurate with what Appellants believed to be the significant aspects of their invention (as evidenced by the disclosure).

III. THE EXAMINER'S ASSERTION OF ACQUIESCENCE

The Examiner alleges that, by failing to submit "Comments" on the Examiner's Statement of Reasons for Allowance during prosecution of the '857 Application, Appellants acquiesced to a plurality of bearings in the claimed separable bearing cartridge as being essential to patentability.

Initially, Appellants dispute the Examiner's conclusion that the Reasons for Allowance in the '857 Application, which cited "a separable bearing cartridge which carries spaced bearings," indicate that claim 1 was allowed for specifying that the cartridge included a plurality of bearings instead one or more bearings. Instead, it is reasonable to conclude from the Reasons for Allowance, particularly when viewed in light of the features emphasized in the specification, that the Examiner considered that it was the "separable" feature of the bearing cartridge that, in combination with other elements of the claimed vertical turbine pump arrangement, rendered claim 1 allowable (considered as a whole).

Furthermore, the Examiner's conclusion that Appellants' failure to submit "Comments" on the Examiner's Reasons for Allowance in the '857 Application constituted an acquiescence that having a plurality of bearings in the claimed bearing cartridge was essential to patentability directly contradicts the Rule (37 C.F.R. § 1.109) in effect at the time the '857 Application was allowed – which stated that "[f]ailure to file such a statement [commenting on the reasons for allowance] **does not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the Examiner.**" (Emphasis

Added). It was entirely reasonable for Appellants to rely on the relevant rule that existed at the time the '857 Application was allowed in concluding that no prejudice would arise from not submitting comments on the Examiner's Reasons for Allowance.

CONCLUSION

For the reasons set forth above and for the reasons contained in the original Appeal Brief, Appellants respectfully submit that all claims of the present application are allowable. Thus, favorable reconsideration and reversal of the Examiner's rejections of claims 15-16, 19-21, and 24-25 by the Honorable Board of Patent Appeals and Interferences is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present Appeal, the Examiner or Honorable Board is respectfully requested to contact D. Richard Anderson (Reg. No. 40.439) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

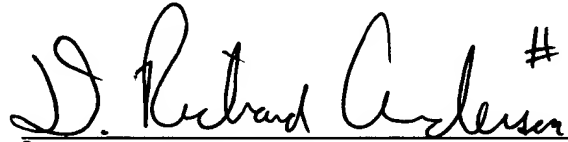
Application No. 09/034,313

Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or
under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

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